

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Michael J. Borg et al.	Examiner:	Tan D. Nguyen
Serial No.:	09/820,457	Group Art Unit:	3689
Filed:	March 28, 2001	Docket:	10006799-1
Title:	SYSTEMS AND METHODS FOR UTILIZING PRINTING DEVICE DATA IN A CUSTOMER SERVICE CENTER		

REPLY BRIEF TO EXAMINER'S ANSWER

Mail Stop Appeal Brief – Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir/Madam:

This Reply Brief is presented in response to the Examiner's Answer mailed November 15, 2010 (Jan. 15 = Sat., Jan. 16 = Sun., Jan. 17 = Holiday, Jan. 18 = two-months), and in support of the Notice of Appeal filed June 30, 2010 and the Appeal Brief filed August 30, 2010, appealing the rejection of claims 1-9, 16-19, 26, and 27 of the above-identified application as set forth in the Final Office Action mailed March 31, 2010.

At any time during the pendency of this application, please charge any fees required or credit any overpayment due to Deposit Account No. 08-2025 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required to Deposit Account No. 08-2025 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1-9, 16-19, 26, and 27.

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ARGUMENT

Reply to Examiner's Response to Argument

Regarding the rejection of claims 27, 26, 16-19, and 1-8 [and 9] under 35 U.S.C. 103(a) as being obvious over Hayward et al., U.S. Patent No. 6,985,877 in view of Cremon et al. or vice versa and Yokomori et al., and the rejection of claims 16-19, 1-8 [and 9], 26, and 27 under 35 U.S.C. 103(a) as being obvious over Hardman et al. in view of Cremon et al. and Yokomori et al. or vice versa, once again, Appellant notes that, in the combinations recited, independent claims 1 and 16 include retrieving printing device data from component memory of the replaceable printing component or components, wherein the printing device data comprises identification information or usage information of the printing device or devices in which the replaceable printing component or components was or were previously installed, with independent claim 1 further including receiving the replaceable printing component from the customer, wherein the replaceable printing component was previously installed in the printing device of the customer. In addition, independent claims 26 and 27 include retrieving printing device data from component memory of the used replaceable printing component, wherein the printing device data comprises identification information or usage information of a printing device in which the replaceable printing component was used or from which the replaceable printing component was removed, with independent claim 27 further including retrieving printing device data from component memory of the replaceable printing component after removal of a replaceable printing component from a printing device

Further to Appellant's previous arguments regarding the combination of the Hayward, Cremon, and Yokomori references, Appellant notes that the Hayward reference simply relates to an automatic supply ordering system for electronically ordering a consumable component or replaceable part in a marking machine (see Hayward, Abstract). As such, the system of the Hayward reference provides electronic identification of a condition of a replaceable component, and automatically electronically sends an offer to purchase a replacement part upon identification of a threshold condition (see Hayward, Abstract). In this regard, and with reference to Fig. 2, the Hayward reference provides that a particular condition may be determined or derived from

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sensors 12 and machine state 14 via firmware 16 such that "[t]he peripheral condition is sent by firmware 16 over bus 32 to an application program running in the computer 30" (emphasis added) (Hayward, col. 4, lines 45-49). In addition, and with reference to Fig. 8, the Hayward reference provides that "a particular condition may be determined or derived from sensors 12 and consumable component 11 via processor, software and logic system 16" (emphasis added) (Hayward, col. 4, lines 49-52).

Thus, with the system of the Hayward reference, the consumable component is a component still installed in the machine 10 or marking apparatus 8, whereby the condition is determined or derived and sent by or via firmware 16 or processor, software and logic system 16 of machine 10 or marking apparatus 8. The Hayward reference, however, does not provide for the consumable component as being a component or components which was or were previously installed in a printing device, and does not provide for the consumable component as being a component which was removed from a printing device. More importantly, with the system of the Hayward reference, removing the consumable component would change the principle of operation of the system and defeat the intended purpose of the system in that the condition of the consumable component could not be determined or derived from sensors 12 and machine state 14, and could not be determined or derived from sensors 12 and consumable component 11. In this regard, Appellant notes that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In addition, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Furthermore, as noted in the Appeal Brief, the "information" derived or determined from the consumable component 11 of the Hayward reference is information "*relating to the condition of the consumable component 11*" (see Hayward, col. 9, lines 12-15, 21-32, and 43-50). Such "information," however, does not relate to the marking apparatus. More specifically, the

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"information" does not include identification information or usage information of a printing device or devices in which the replaceable printing component or components was or were previously installed, and does not include identification information or usage information of a printing device in which the replaceable printing component was used or from which the replaceable printing component was removed, as recited in the present claims.

Regarding the Cremon reference, as previously noted, the publication date of the Cremon reference is December 19, 2002, and the filing date of the Cremon reference is July 24, 2001. The filing date of the present application, however, is March 28, 2001. Thus, the filing date of the present application precedes the filing date of the Cremon reference. Also as previously noted, the Cremon reference claims the benefit of U.S. Provisional Applications No. 60/221,562, filed July 28, 2000, and No. 60/223,941, filed Aug. 9, 2000. Accordingly, as the Examiner appears to rely on Provisional Applications No. 60/221,562, filed July 28, 2000, and No. 60/223,941, filed Aug. 9, 2000 (see Examiner's Answer, page 17), the determination as to whether the relied-upon subject matter is properly supported in Provisional Applications No. 60/221,562 and No. 60/223,941, is tantamount to the propriety of the rejections.

Regarding Provisional Application No. 60/221,562, while the Examiner did not provide a copy of this application, Appellant was able to obtain a copy of Provisional Application No. 60/221,562 via Public PAIR. Upon Appellant's review of the portions of Provisional Application No. 60/221,562 relied upon by the Examiner (e.g., Figs. 2, 3, page 3, lines 15-35) (see Examiner's Answer, page 7), Appellant submits that these portions do not support the subject matter of paragraphs [0045], [0046], and [0061] of the Cremon reference, as relied upon by the Examiner in the rejections under 35 U.S.C. 103(a) (see, e.g., Examiner's Answer, page 7 and pages 13-14). Rather, the portions of Provisional Application No. 60/221,562 relied upon by the Examiner simply provide for reprogramming or reconfiguration parameters to be loaded into the printer firmware. Paragraphs [0045], [0046], and [0061] of the Cremon reference, however, provide for data to be written to RFID tags where the data may be generated as a response to system status or information read from the tag, or where the data may contain various kinds of

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information, e.g. product information, control data for reading other equipment, such as luggage handling equipment in airports, expiry of foods stuff, etc. (Cremon, para. [0045]).

Regarding Provisional Application No. 60/223,941, the Examiner did not provide a copy of this application, and this application is not available on Public PAIR. Appellant, therefore, is unable to assess support for the subject matter of paragraphs [0045], [0046], and [0061] of the Cremon reference, as relied upon by the Examiner in the rejections under 35 U.S.C. 103(a).

Nevertheless, to the extent the Cremon reference provides that "[a] code is read from the RFID tag" (Cremon, para. [0044]), and provides that "[d]ata may also be written to the RFID tags" (Cremon, para. [0045]), Appellant submits that such "code" or "data" does not comprise identification information or usage information of a printing device or devices in which a replaceable printing component or components was or were previously installed, or was used or from which was removed, as recited in the present claims.

Regarding the Yokomori reference, as previously noted, this reference simply relates to a recycling method for a process cartridge and a process cartridge produced thereby (see Yokomori, Abstract). More specifically, the Yokomori reference provides that the process of recycling the process cartridge simply includes (1) collection, (2) classification, (3) disassembling, (4) selection, (5) cleaning, (6) inspection, and (7) reassembling (see Yokomori, col. 35, line 50 - col. 36, line 16). Contrary to the assertion of the Examiner, however, the process of recycling the process cartridge in the Yokomori reference does not include "test the used replaceable component for a defect, storing the data and associate the customer" (see Examiner's Answer, page 9). More importantly, the Yokomori reference does not include retrieving printing device data from component memory of a replaceable printing component or components, or retrieving printing device data from component memory of the used replaceable printing component, or retrieving printing device data from component memory of the replaceable printing component after removal of a replaceable printing component from a printing device, wherein the printing device data comprises identification information or usage information of a printing device or devices in which the replaceable printing component or

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components was or were previously installed, or was used or from which was removed, as recited in the present claims.

Appellant, therefore, continues to submit that the combination of the Hayward, Cremon, and Yokomori references does not teach or suggest all of the limitations of independent claims 1, 16, 26, and 27. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Further to Appellant's previous arguments regarding the combination of the Hardman, Cremon, and Yokomori references, Appellant notes that the Hardman reference simply relates to an electronic tire maintenance system provided for measuring a parameter of a device at a first location where the device is a tire tag mounted inside a tire that measures tire data and transmits that data to a remote source in response to an interrogation request, an alert condition, or automatically on a periodic basis (see Hardman, Abstract). More specifically, the Hardman reference "*...relates in general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags, where each tag has an electronic sensor circuit that conserves power by "sleeping" and periodically "waking-up" to measure and store tire parameters, such as temperature and pressure*" (emphasis added) (Hardman, para. [0002]).

In this regard, Appellant continues to submit that the Hardman reference is not analogous art in relation to the present claims in that the general scope of the Hardman reference (viz., a tire parameter monitoring system) is outside the field of endeavor of the present claims (viz., retrieving printing device data from component memory of a replaceable printing component). In addition, Appellant submits that the particular problem with which the Hardman reference is involved (viz., monitoring tires for parameters such as temperature and pressure) is not pertinent to the present claims (viz., retrieving printing device data from component memory of a replaceable printing component). In order to rely on a reference as a basis for rejection of an Appellant's invention, the reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

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In addition, as previously noted, the publication date of the Hardman reference is June 20, 2002, and the filing date of the Hardman reference is July 26, 2001. The filing date of the present application, however, is March 28, 2001. Thus, the filing date of the present application precedes the filing date of the Hardman reference. Also as previously noted, the Hardman reference claims the benefit of U.S. Provisional Application Ser. No. 60/220,896, filed July 26, 2000. Accordingly, as the Examiner appears to rely on Provisional Application No. 60/220,896, filed July 26, 2000 (see Examiner's Answer, page 13), the determination as to whether the relied-upon subject matter is properly supported in Provisional Application No. 60/220,896, is tantamount to the propriety of the rejection.

Regarding Provisional Application No. 60/220,896, while the Examiner did not provide a copy of this application, Appellant was able to obtain a copy of Provisional Application No. 60/220,896 via Public PAIR. Upon Appellant's review of the portions of Provisional Application No. 60/220,896 relied upon by the Examiner (e.g., Figs. 2, 3, page 3, lines 15-35; Figs. 1A, 12, 15, 21, pages 15-21, and pages 33-39) (see Examiner's Answer, page 13), Appellant submits that these portions do not support the subject matter of paragraphs [0253], [0258], [0261], [0262]-[0265] of the Hardman reference, as relied upon by the Examiner in the rejection under 35 U.S.C. 103(a) (see, e.g., Examiner's Answer, pages 12-13). More importantly, Appellant submits that the subject matter of at least paragraphs [0236]-[0290] of the Hardman reference is not supported by Provisional Application No. 60/220,896 (compare, e.g., para. [0076]-[0235] of the Hardman reference with pages 10-47 of Provisional Application No. 60/220,896, and para. [0291]-[0293] of the Hardman reference with page 48 of Provisional Application No. 60/220,896).

Nevertheless, to the extent the Hardman reference provides for "improving efficiency for servicing" and "early identification of problems" (see Examiner's Answer, page 13), Appellant notes that in full context, the Hardman reference provides that "tire servicing can be directed to only problem tires and efficiency in servicing [problem tires] can be achieved," and provides that "early identification of problems such as leaks can lead to immediate service which can potentially eliminate further damage to the tire and associated costs such as new tire, servicing

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time, equipment damage, lost equipment utilization, potential collateral damages or personal injuries" (Hardman, para. [0234]). Thus, the "servicing" and "early identification of problems" of the Hardman reference is that associated with tires. In addition, to the extent the process of the Hardman reference can be used for monitoring an "other device/system" (see Examiner's Answer, page 13), Appellant notes that the Hardman reference simply provides that *"the disclosed process can be used to measure other vehicle parameters, such as vehicle/axle load(s), tire revolutions (mileage), exhaust emissions, oil pressure, battery charge, coolant levels, brake wear, transmission fluid level, power steering fluid level, brake fluid level, clutch fluid level, windshield wiper fluid level, status of headlights and taillights, etc."* (Hardman, para. [0309]). More importantly, Appellant submits that the subject matter of para. [0309] of the Hardman reference, as alternatively relied upon by the Examiner (see Examiner's Answer, page 13), is not supported by Provisional Application No. 60/220,896 and, therefore, is not entitled to the priority date of July 26, 2000.

Furthermore, as previously noted and as further outlined above, Appellant submits that neither the Cremon reference nor the Yokomori reference overcome the noted shortcomings of the Hayward or the Hardman reference, and do not include retrieving printing device data from component memory of a replaceable printing component or components, or retrieving printing device data from component memory of the used replaceable printing component, or retrieving printing device data from component memory of the replaceable printing component after removal of a replaceable printing component from a printing device, wherein the printing device data comprises identification information or usage information of a printing device or devices in which the replaceable printing component or components was or were previously installed, or was used or from which was removed, as recited in the present claims.

Appellant, therefore, continues to submit that the combination of the Hardman, Cremon, and Yokomori references does not teach or suggest all of the limitations of independent claims 1, 16, 26, and 27. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

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Thus, for the reasons set forth above, as well as the reasons set forth in the Appeal Brief filed August 30, 2010, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claims 1, 16, 26, and 27, and submits that independent claims 1, 16, 26, and 27, and the dependent claims depending therefrom, are each patentably distinct from the cited references. Appellant, therefore, respectfully submits that the rejections under 35 U.S.C. 103(a) are not correct and should be withdrawn, and submits that claims 1-9, 16-19, 26, and 27 should be allowed.

CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Respectfully submitted,

Michael J. Borg et al.,

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